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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Technology Center 2100

Application Number: 09/682,488
Filing Date: September 07, 2001
Appellant(s): LAMMING ET AL.

Thomas Zell
Registration No. 37,481
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 20, 2006 appealing from the

Office action mailed April 18, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct, in that no amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The examiner relied upon Lamming et al. (U.S. Patent No. 5,862,321), Fogarty

(U.S. Patent No. 6,311,180), and Wang et al. (U.S. Patent No. 6,493,551).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-15 and 17-26 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Lamming et al., U.S. Patent No. 5,862,321, further in view of Fogarty,

U.S. Patent No. 6,311,180.

Lamming teaches the invention substantially as claimed including a system for

transferring electronic documents between portable computer devices, and between

such devices and various forms of office equipment (see abstract).

Regarding claim 1, Lamming teaches a method for controlling a document

service request at a mobile computing device, comprising:

receiving a user selection of a selected document, which has an externally

available list of document services that may be applied to it, identified by a document

reference that is accessible on a document server (col. 10, lines 15-30, Lamming

discloses a document being chosen and retrieved from an electronic database, col. 8,

lines 47-54, col. 9, lines 10-27, col. 10, lines 15-36, Lamming discloses various options

for the document including transfer to other TAB devices and different ways to print the

document);

initiating, at the mobile computing device, the document service request in

response to the user selection of a document service from the list of document services

available (col. 8, lines 47-54, col. 9, lines 10-27, col. 10, lines 15-36);

said initiating adding to the document service request a first parameter identifying

the selected document accessible to the document server (col. 3, lines 36-40, Lamming

discloses a file server sending documents to a portable electronic device, also called

TAB, col. 10, lines 15-36);

receiving, at the mobile device in response to a user request, a list of document

services that may be applied to the selected document (col. 8, lines 47-54, col. 9, lines

10-27, col. 10, lines 15-36, Lamming discloses various options for the document

including transfer to other TAB devices and different ways to print the document);

obtaining, at the mobile computing device, device information identifying a type of

output device available over one of two communications channels (col. 10, lines 38-49,

Lamming discloses an available printer, fax, etc... to print out documents from the portable electronic device);

adding, at the mobile computing device, the device information as a second parameter to the document service request (col. 9, lines 19-27, Lamming discloses print operation instruction attached to a document of a persons TAB);

transmitting, from the mobile computing device, the parameters of the document service request to the document server over one of the two communications channels (col. 9, lines 64-67, col. 10, lines 1-3, Lamming discloses a document request for printing set to a file server and then printed out); and

controlling, at the mobile computing device, a connection between the document server and the output device to transmit there between the selected document in a format suitable for the output device (col. 4, lines 50-56, Lamming discloses the user of a proper format, for eventual transfer, on the server);

the mobile computing device establishing the connection with the document server over a first of the two communications channels and with the output device over a second of the two communications channels (col. 3, lines 36-40, col. 10, lines 38-49).

Lamming fails to teach the limitation further including the use of a web browser operating at the mobile computing device, a document server communicating with a web server, and a web page from the web server that has embedded therein a control module for communicating between the document server and the output device with the mobile computing device using the control module.

However, Fogarty teaches a system and method for dynamically mapping and formatting information for presentation on a computer display device (see abstract). Fogarty teaches the use of a web browser on a cell phone receiving a document/web page from a web server (col. 4, lines 42-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lamming in view of Fogarty to use a web browser operating at the mobile computing device, a document server communicating with a web server, and a web page from the web server that has embedded therein a control module for communicating between the document server and the output device with the mobile computing device using the control module. One would be motivated to do so because a web browser and server allows for more efficient document viewing and transfer.

Regarding claim 2, Lamming teaches the method according to claim 1, wherein the document server and the output device have no preexisting communications channel there between (col. 3, line 67, col. 4, lines 1-5, Lamming discloses a document handling subsystem communicating with many output devices).

Regarding claim 3, Lamming teaches the method according to claim 1, wherein the document server and the output device have an inadequate preexisting communications channel there between (col. 3, line 67, col. 4, lines 1-5).

Regarding claim 4, Lamming teaches the method according to claim 1, wherein the document server prepares the document identified by the first parameter in the format suitable for the output device (col. 3, lines 36-40, col. 4, lines 50-56).

Regarding claim 5, Lamming teaches the method according to claim 4, wherein the suitable format prepared by the document server conforms to at least one format that the output device is adapted to process (col. 4, lines 50-56).

Regarding claim 6, Lamming teaches the method according to claim 4, wherein the document server applies one of a document enrichment, translation, conversion, summarization, recommender service to the document before preparing the document in the suitable format (col. 9, lines 28-33, Lamming discloses a document going through a summarizing and translation service).

Regarding claim 7, Lamming teaches the method according to claim 1, wherein the mobile computing device sets up a route between the document server and the output device (col. 9, lines 64-67, col. 10, lines 1-3).

Regarding claim 8, Lamming teaches the method according to claim 1, wherein the output device is one of a printer, a display, a file server, and a speaker (col. 3, line 67, col. 4, lines 1-5).

Regarding claim 9, Lamming teaches the method according to claim 1, wherein the format suitable for the output device is a device dependent format (col. 4, lines 50-56).

Regarding claim 10, Lamming teaches the method according to claim 1, wherein the first of the two communications channels is an unlimited communications channel and the second of the two communications channels is a limited communications channel (col. 11, lines 34-38, Lamming discloses the use of GSM; col. 5, lines 29-35, Lamming discloses IR used to send documents between the document handling subsystem and TAB).

Regarding claim 11, Lamming teaches the method according to claim 10, wherein the two communications channels are wireless communications channels (col. 11, lines 34-38, col. 5, lines 29-35).

Regarding claim 12, Lamming teaches the method according to claim 10, wherein the limited communications channel is a wired communications channel and the unlimited communications channel is a wireless communications channel (col. 11, lines 34-38, col. 5, lines 41-43, Lamming discloses the use of a wired link for communicating).

Regarding claim 13, Lamming teaches the method according to claim 1, wherein the first and the second of the two communications channels are limited communications channels (col. 5, lines 29-35).

Regarding claim 14, Lamming teaches the method according to claim 1, further comprising processing the document service request at the document server by:

locating the document identified by the first parameter of the document service request (col. 3, lines 36-40);

loading a driver corresponding to the device information specified in the document service request (col. 3, lines 36-40, col. 9, lines 13-19);

rendering the located document using the loaded driver (col. 9, lines 13-19, Lamming discloses an electronic document fetched from a database);

storing the rendered document in a print file (col. 9, lines 20-27, Lamming discloses a print operation deferred and stored on TAB); and

transmitting the print file to the mobile computing device over the first of the two communications channels (col. 9, lines 22-27).

Regarding claim 15, Lamming teaches the method according to claim 1, further comprising applying one or more specified services to the document as part of the document service request; wherein the one or more specified services is one of a summarization service, an enrichment service, a recommender service, and a translation service (col. 9, lines 28-33).

Regarding claim 17, Lamming teaches the method according to claim 1, wherein

the mobile computing device transforms the document into the format suitable for the

output device (4, lines 50-56).

Regarding claim 18, Lamming teaches the method according to claim 1, wherein

the device information is obtained by executing a discovery request at the mobile

computing device (col. 9, lines 22-27, Lamming discloses a sensing of the Picador).

Regarding claim 19, Lamming teaches the method according to claim 1, wherein

the device information is obtained using a profile of the output device and confirmed by

executing a discovery request at the mobile computing device (col. 9, lines 22-27).

Regarding claim 20, Lamming teaches the method according to claim 1, wherein

one of the first of the two communications channels and the second of the two

communications channels of the mobile computing device is routed through a second

mobile computing device having at least two communications channels (col. 10, lines 4-

8, Lamming discloses a file transferred from Ann to Bob and then to a printer).

Regarding claim 21, Lamming teaches the method according to claim 1, wherein

the document server forms part of an input device (col. 3, lines 36-40, Lamming

discloses the exchange of documents involving a file server).

Regarding claim 22, Lamming teaches the method according to claim 1, wherein device information identifying the type of output device available over the first communications channel is a class of service (col. 9, lines 22-27, Lamming discloses the TAB sensing the Picador).

Regarding claim 23, Lamming teaches the method according to claim 22, wherein the class of service is wireless printing (col. 9, lines 22-27, Lamming discloses the IR communication to the printer).

Regarding claim 24, Lamming teaches the method according to claim 1, wherein the first parameter and the second parameter are specified using a name of the document (col. 7, lines 18-20, Lamming discloses that information transmitted includes a document name).

Regarding claim 25, Lamming teaches an article of manufacture, comprising:

a storage medium (col. 5, lines 44-58, Lamming discloses TAB); and

program instructions stored on the storage medium for controlling a document service request on a mobile computing device having a processor; the processor in executing the program instructions (col. 5, lines 44-58, col. 3, lines 36-40, col. 10, lines 56-58, Lamming discloses TAB having a processor which executes instructions):

receiving a user selection of a selected document, which has an externally available list of document services that may be applied to it, identified by a document reference that is accessible on a document server (col. 10, lines 15-30, Lamming discloses a document being chosen and retrieved from an electronic database, col. 8, lines 47-54, col. 9, lines 10-27, col. 10, lines 15-36, Lamming discloses various options for the document including transfer to other TAB devices and different ways to print the document);

initiating, at the mobile computing device, the document service request in response to a user request of a document service from the list of document services available (col. 8, lines 47-54, col. 9, lines 10-27, col. 10, lines 15-36);

said initiating adding to the document service request a first parameter identifying the selected document accessible to the document server (col. 3, lines 36-40, Lamming discloses a file server sending documents to a portable electronic device, also called TAB, col. 10, lines 15-36);

receiving, at the mobile device in response to a user request, a list of document services that may be applied to the selected document (col. 8, lines 47-54, col. 9, lines 10-27, col. 10, lines 15-36, Lamming discloses various options for the document including transfer to other TAB devices and different ways to print the document);

obtaining, at the mobile computing device, device information identifying a type of output device available over one of two communications channels (col. 10, lines 38-49);

adding, at the mobile computing device, the device information as a second parameter to the document service request (col. 9, lines 19-27);

transmitting, from the mobile computing device, the parameters of the document

service request to the document server over one of the two communications channels

(col. 9, lines 64-67, col. 10, lines 1-3); and

controlling, at the mobile computing device, a connection between the document

server and the output device to transmit there between the selected document in a

format suitable for the output device (col. 4, lines 50-56);

the mobile computing device establishing the connection with the document

server over a first of the two communications channels and with the output device over

a second of the two communications channels (col. 3, lines 36-40, col. 10, lines 38-49).

Lamming fails to teach the limitation further including the use of a web browser

operating at the mobile computing device, a document server communicating with a

web server, and a web page from the web server that has embedded therein a control

module for communicating between the document server and the output device with the

mobile computing device using the control module.

However, Fogarty teaches the use of a web browser on a cell phone receiving a

document/web page from a web server (col. 4, lines 42-67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Lamming in view of Fogarty to use a web browser operating at the

mobile computing device, a document server communicating with a web server, and a

web page from the web server that has embedded therein a control module for

communicating between the document server and the output device with the mobile

computing device using the control module. One would be motivated to do so because

a web browser and server allows for more efficient document viewing and transfer.

Regarding claim 26, Lamming teaches a mobile computing device for controlling

a document service request, comprising:

a memory for storing program instructions (col. 10, lines 53-55, Lamming

discloses instructions stored in TAB memory); and

a processor for executing the program instructions stored in the memory; the

processor in executing the program instructions (col. 10, lines 53-55, Lamming

discloses a processor for executing instructions in TAB memory):

receiving a user selection of a selected document, which has an externally

available list of document services that may be applied to it, identified by a document

reference that is accessible on a document server (col. 10, lines 15-30, Lamming

discloses a document being chosen and retrieved from an electronic database, col. 8,

lines 47-54, col. 9, lines 10-27, col. 10, lines 15-36, Lamming discloses various options

for the document including transfer to other TAB devices and different ways to print the

document);

initiating, at the mobile computing device in response to a user request in

response to a user selection of a document service request by selecting a document

service from the list of document services available (col. 8, lines 47-54, col. 9, lines 10-

27, col. 10, lines 15-36);

said initiating adding to the document service request a first parameter identifying

the selected document accessible to the document server (col. 3, lines 36-40, Lamming

discloses a file server sending documents to a portable electronic device, also called

TAB, col. 10, lines 15-36);

receiving, at the mobile device, a list of document services that may be applied to

the selected document (col. 8, lines 47-54, col. 9, lines 10-27, col. 10, lines 15-36,

Lamming discloses various options for the document including transfer to other TAB

devices and different ways to print the document);

obtaining, at the mobile computing device, device information identifying a type of

output device available over one of two communications channels (col. 10, lines 38-49);

adding, at the mobile computing device, the device information as a second

parameter to the document service request (col. 9, lines 19-27);

transmitting, from the mobile computing device, the parameters of the document

service request to the document server over one of the two communications channels

(col. 9, lines 64-67, col. 10, lines 1-3); and

controlling, at the mobile computing device, a connection between the document

server and the output device to transmit there between the selected document in a

format suitable for the output device (col. 4, lines 50-56);

the mobile computing device establishing the connection with the document

server over a first of the two communications channels and with the output device over

a second of the two communications channels (col. 3, lines 36-40, col. 10, lines 38-49).

Lamming fails to teach the limitation further including the use of a web browser operating at the mobile computing device, a document server communicating with a web server, and a web page from the web server that has embedded therein a control module for communicating between the document server and the output device with the mobile computing device using the control module.

However, Fogarty teaches the use of a web browser on a cell phone receiving a document/web page from a web server (col. 4, lines 42-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lamming in view of Fogarty to use a web browser operating at the mobile computing device, a document server communicating with a web server, and a web page from the web server that has embedded therein a control module for communicating between the document server and the output device with the mobile computing device using the control module. One would be motivated to do so because a web browser and server allows for more efficient document viewing and transfer.

3.   Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lamming and Fogarty further in view of Wang et al., U.S. Patent No. 6,493,551.

Lamming teaches the invention substantially as claimed including a system for transferring electronic documents between portable computer devices, and between such devices and various forms of office equipment (see abstract). Fogarty teaches the invention substantially as claimed including a system and method for dynamically

mapping and formatting information for presentation on a computer display device (see abstract).

As to claim 16, Lamming and Fogarty teach the method of claim 1.

Lamming and Fogarty fail to teach the limitation further including recording the document service request for accounting purposes at the mobile computing device.

However, Wang teaches a GSM MOU bypass for delivering calls to GSM subscribers roaming to CDMA networks (see abstract). Wang teaches the use of collecting billing information (col. 9, lines 10-20).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lamming and Fogarty in view of Wang to record the document service request for accounting purposes at the mobile computing device. One would be motivated to do so because it allows for a proper bill to be provided to a user.

(10) Response to Argument

The Examiner summarizes the various points raised by the appellant and addresses replies individually.

With regards to section B of the appeal brief, the applicant argues, with respect to independent claims 1, 25, and 26, that Lamming taken in combination with Fogarty fails to disclose or suggest Appellant's claimed method of receiving a control module embedded in a web page or using the control module for controlling a document service request.

In response, the examiner respectfully disagrees:

The Applicant's specification in paragraph 0121 states "In one instance, the control module 1610 is an ActiveX control embedded in a web page running using the Pocket Internet Explorer operating system." This portion of the specification does not define the terminology "embedded." One of ordinary skill in the art would consider "embedding" in this context to merely mean running a program on a device. In Fogarty the web page is transmitted to the mobile device and runs on the device, as seen in column 4, lines 42-67. In order to run on the device, the web page must necessarily include mapping to control how the pages are displayed. The mapping system, specifically seen in column 4, lines 54-61, is considered by the examiner to be the claimed "control module." Thus, Lamming in combination with Fogarty clearly teaches receiving a control module embedded in a web page or using the control module for controlling a document service request.

With regards to section B1 of the appeal brief, the applicant argues that there is no suggestion to modify or combine the references of Lamming et al. and Fogarty.

In response, the examiner respectfully disagrees:

As admitted by the Appellant, Fogarty teaches a method for displaying documents on a limited display. The Tab device, which is a form of personal digital assistant, PDA, of Lamming has a limited display. One of ordinary skill in the art would be motivated to modify Lamming to use the display method taught by Fogarty to improve the mobile computing device of Lamming et al.

With regards to section B2 of the appeal brief, the applicant argues, with respect to independent claims 1, 25, and 26, that Lamming taken in combination with Fogarty fails to disclose or suggest Appellant's claimed method of receiving a control module embedded in a web page or using the control module for controlling a document service request.

In response, the examiner respectfully disagrees:

The Applicant's specification in paragraph 0121 states "In one instance, the control module 1610 is an ActiveX control embedded in a web page running using the Pocket Internet Explorer operating system." This portion of the specification does not define the terminology "embedded." One of ordinary skill in the art would consider "embedding" in this context to merely mean running a program on a device. Lamming discloses a TAB device, which is a portable electronic device, having an embedded control module which controls receiving a document, a document request for printing, and the printing of the document (columns 8-10). Lamming does not teach a web browser running on a portable electronic device, a document server communicating with a web server, and a web page from the web server that has embedded therein a control module for communicating between the document server and the output device with the mobile computing device using the control module. In Fogarty the web page is transmitted to the mobile device and runs on the device, as seen in column 4, lines 42-67. In order to run on the device, the web page must necessarily include mapping to control how the pages are displayed. The mapping system, specifically seen in column

4, lines 54-61, is considered by the examiner to be the claimed "control module." Thus, Lamming in combination with Fogarty clearly teaches receiving a control module embedded in a web page or using the control module for controlling a document service request.

In response to applicant's argument that Fogarty discloses a mapping system, with three principle steps for processing a display document to conform a display device according to viewing preferences of a user of the display device, and that those steps do no serve, or suggest serving, to control a connection between a document server and an output device, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The claimed limitations of the application are very similar to what you would see in a Blackberry or Treo device. The combination of Lamming and Fogarty fully disclose those claimed limitations.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Avi Gold

Conferees:

Lynne H. Browne
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ARIO ETIENNE
SUPERVISORY PATENT EXAMINER